

### **REMARKS/ARGUMENTS**

This paper is responsive to the Office Action mailed October 29, 2009. Claims 1, 2, 4, 5, 9-18, 20 and 24-31 were pending before submission of this paper. Claims 1, 2, 4, 5, 9-18, 20 and 24-31 stand rejected. Specifically, claims 1, 2, 4, 5, 9-18, 20 and 24-31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Thrall (US 2005/0120311 A1) in view of Skinner et al. (US 2005/0105677). Applicant respectfully disagrees. Claims 1, 13, and 24 have been amended. Support for all amended claims can be found in the specification, and no new matter has been added by these amendments. Reconsideration of the claims in view of the amendments and the following remarks is respectfully requested.

#### **I. Examiner Interview**

A telephonic interview with Examiner Retta was conducted on December 10, 2009 at 11:00 AM, Eastern time. The undersigned represented Applicant in the interview. During the interview claim 1 was discussed and elements of the claim were contrasted with the teachings of the Thrall and Skinner references. Examiner Retta graciously offered a strategy for amending claim 1 that would overcome the pending rejection. In particular, Examiner Retta suggested distinguishing the “link” recited in claim 1 from the “advertisement” in order to distinguish elements in the claim from that which is shown in the cited art. Applicant thanks Examiner Retta for a productive discussion and present this response accordingly.

#### **II. Claims 1, 2, 4, 5, 9-18, 20 and 24-31 Are Allowable Under 35 U.S.C. § 103 Over Thrall in View of Skinner et al.**

Claims 1, 2, 4, 5, 9-18, 20 and 24-31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Thrall in view of Skinner et al.

With regard to rejections under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (*i.e.*, the reference teachings establish a *prima facie* case of obviousness) is more probable than not. M.P.E.P. § 2142. Accordingly, “the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”

M.P.E.P. § 2142; *see KSR International Co. v. Teleflex, Inc.*, 550 U.S.398, 82 USPQ 2d 1385, 1395-97 (2007).

**A. Independent Claim 1**

Applicant's claim 1, as amended, recites:

1. A computer-implemented method for determining when to place an advertisement for an item on a first page of search results for a search request related to the item, the method comprising:  
under control of one or more computer systems configured with executable instructions,  
receiving search data relating to previously-executed searches, the search data indicating:  
search terms submitted by users; placement of links to information for the item within corresponding sets of search results provided for display to users; and whether the users selected the link for the item from the search results;  
determining, based at least in part on the received search data, an extent relating a search term to an item, the extent being a function of at least:  
a frequency of selection of a link to information for the item when the link is displayed; and  
a page number on which the link was presented in a set of search results generated by execution of the search term, the extent being determined to be greater for a higher page number at the same frequency of selection; and  
upon receiving a search request containing the search term, determining to place an advertisement for the item on the first page of the search results for the search request when the extent exceeds calculated extents relating the search term to other items for which links to information for said other items appear in the search results for the search request, said determining being independent of a page number of the search results on which the link for the item is configured to be displayed, wherein said search results are to be provided to a consumer computer system different from said one or more computer systems, and wherein the link for the item is distinct from the advertisement for the item.

As discussed during the aforementioned interview, the Examiner suggested amending the claim to specify that "the link for the item and the advertisement for the item are distinct from one another" to overcome the present rejection. In particular, as discussed, the combination of Thrall

and Skinner proposed in the Office Action does not teach or suggest “upon receiving a search request containing the search term, determining to place an advertisement for the item on the first page of the search results for the search request when the extent exceeds calculated extents relating the search term to other items for which links to information for said other items appear in the search results for the search request” when “the link for the item and the advertisement for the item are distinct from one another,” as recited in claim 1.

Applicant has amended claim 1 per the Examiner’s suggestion and, therefore, submit that claim 1 is allowable under 35 U.S.C. § 103 over Thrall in view of Skinner at least for the reasons discussed during the aforementioned interview. Therefore, Applicant respectfully request that the rejection of claim 1 under 35 U.S.C. § 103 be withdrawn.

**B. Independent Claims 13 and 24**

Applicant respectfully submits that claims 13 and 24 are allowable at least for reasons including some of those discussed above and during the interview in connection with claim 1. For example, amended claim 13 recites a computer-implemented method that includes “requesting an advertisement for the item to be placed on the first page of search results to be provided to said consumer computer system in response to the received search query, independent of a page number of the search results on which the link for the item is configured to be displayed” where “the advertisement for the item [is] distinct from the link for the item.” Amended claim 24 recites a computer system that includes “means for requesting an advertisement for the item to be placed on the first page of search results to be provided to said consumer computer system in response to the received search query, independent of a page number of the search results on which the link for the item is configured to be displayed” where “the advertisement for the item [is] distinct from the link for the item.”

Thus, per the Examiner’s suggestion, Applicant has amended claims 13 and 24 to recite that “the advertisement for the item [is] distinct from the link for the item.” Accordingly, at least for reasons including some of those discussed above, Applicant respectfully submits that claims 13 and 24 are allowable under 35 U.S.C. § 103 over Thrall in view of Skinner. Therefore,

Applicant respectfully requests that the rejection of claims 13 and 24 under 35 U.S.C. § 103 be withdrawn.

**C. Dependent Claims 2, 4, 5, 9-12, 14-18, 20, 24, and 25-31**

Each of claims 2, 4, 5, 9-12, 14-18, 20, 24, and 25-31 depend from claims 1, 13, and 24. Therefore, Applicant respectfully submits that claims 2, 4, 5, 9-12, 14-18, 20, 24, and 25-31 are allowable under 35 U.S.C. § 103 over Thrall in view of Skinner et al. at least for being dependent on an allowable claim. In addition, Applicant respectfully submits that at least some of claims 2, 4, 5, 9-12, 14-18, 20, 24, and 25-31 are allowable for further defining patentable subject matter. For example, claim 2 recites that “the first page of the search results for the search request excludes any link to information for the item that is unassociated with the advertisement.” While the Office Action rejects this claim under 35 U.S.C. § 103 over Thrall in view of Skinner, the Office Action does not address this element and, therefore, has not made a *prima facie* case of obviousness with respect to the claim. Indeed, Applicant submits that such subject matter as recited in claim 2 is not disclosed, taught, or even suggested by the proposed combination of Thrall and Skinner.

As another example, claim 9 recites that “the search data is derived from information sources.” Claim 10, which depends from claim 9, recites that “the information sources include web pages.” Claim 11, which depends from claim 9, recites that “the information sources include web pages.” Claim 12, which also depends from claim 9 recites that “the information sources include content not available through the Internet.” As with claim 2, the Office Action rejects the claims under 35 U.S.C. § 103 over Thrall in view of Skinner, but does not address the elements recited in claims 9-12 and, thus, has not made a *prima facie* case of obviousness. Further, Applications respectfully submit that such subject matter as recited in claims 9-12 is not disclosed, taught, or suggested by Thrall or Skinner, either individually or in combination.

Therefore, for at least the foregoing reasons, Applicant respectfully submits that claims 2, 4, 5, 9-12, 14-18, 20, 24, and 25-31 are allowable under 35 U.S.C. § 103 over Thrall in

view of Skinner. Accordingly, Applicant respectfully requests that the rejection of claims 2, 4, 5, 9-12, 14-18, 20, 24, and 25-31 under 35 U.S.C. § 103 be withdrawn.

### **III. Amendment To The Claims**

Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter. In addition, by focusing on specific claims and claim elements in the discussion above, Applicant does not imply that other claim elements are disclosed or suggested by the references. In addition, any characterizations of claims and/or cited art are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by another prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present disclosure.

### **CONCLUSION**

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 10/748,694  
Amdt. dated January 27, 2010  
Reply to Office Action of October 29, 2009

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

/Scott S. Adams/

Scott S. Adams  
Reg. No. 63,302

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 206-467-9600  
Fax: 415-576-0300  
SSA:jis  
62354071 v1